IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Minerva M. Yeung et al..   Art Unit : 2629

Serial No. : 10/579,046   Examiner : Robert M. Stone

Filed   : 5/9/2006   Assignee : Intel Corporation

Title   : ELECTRONIC PEN-COMPUTER MULTIMEDIA INTERACTIVE

SYSTEM

Mailstop AF
Commissioner for Patents
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Pre-Appeal Brief Request for Review

Independent claim 1 includes the claim element "determining a position of an electronic pen on a page of the pre-existing printed material, wherein the pre-existing printed material has not been modified for use with the computer system and the electronic pen ..." Independent claims 7 and 12 contain substantially similar limitations. The independent claims 1, 7, and 12 were finally rejected under 35 USC § 103(a) as being unpatentable over Ohara et al. (U.S. Patent No. 5,739,814) in view of Curry (U.S. Patent No. 6,055,552).

The Office Action admits on page 3 that Ohara does not expressly disclose "wherein the pre-existing printed material has not been modified for use with the computer system and the electronic pen." Ohara is not designed to work with pre-existing printed materials, and in fact, Ohara requires an electronic book that has been specifically adapted to operate with the computer system. Ohara repeatedly describes the book as an "electronic book" containing "sheet cards" containing image data and the like that are "printed or recorded one at a time." (See column 1, lines 8-12; column 2,

lines 29-37.)   The electronic book is also described as having a spline specially adapted to include electronic terminals and pages printed with conductive paint or ink. See Ohara, column 6, lines 61-67 and Fig. 7.

The Office Action states on page 3 that "Curry discloses a pen input system ... having pre-existing printed material (sheets of paper ... *that lay on top of the clipboard* are pre-existing blank paper or preprinted documents having data entry fields..." (emphasis added). The system of Curry requires a digitizing clipboard to detect the pen position and does not determine a position of an electronic pen on a page of the pre-existing printed material without the clipboard. The operation of Curry's clipboard and pen (stylus) is described, inter alia, in Curry, column 11, lines 18-328, which states "The clipboard is normally maintained in a sleep mode, and is awakened when the user places the writing tip [of the stylus/pen] in contact with an object, thus closing a switch in the stylus triggers an interrupt signal within the CPU. This interrupt signal causes the CPU to empower clipboard electronics and begin actively "listening" to the stylus. When "listening," the clipboard preferably samples data each ten milliseconds, although only data representing writings on the clipboard (e.g., when the tip-down switch is concurrently closed) will be passed to the data memory 69 as a stream of stylus data."

The combination of the system of Ohara with only the pre-existing printed material of Curry and omitting the clipboard that is necessary to "determin[e] a position of an electronic pen on a page of the pre-existing printed material" is clear error. Furthermore, adding the clipboard of Curry to the system of Ohara would be superfluous, as the system of Ohara would still require that the printed material be modified for use with Ohara's system and Ohara's electronic pen.

Because the cited combination of references fails to teach the claim element "determining a position of an electronic pen on a page of the pre-existing printed material, wherein the pre-existing printed material has not been modified for use with the computer system and the electronic pen ...," a prima facie case of obviousness has not been made and clear error has been committed. Attorney for Applicants respectfully requests withdrawal of the rejections under 35 USC § 103.

Respectfully submitted,

Dated: 12/3/2009   /D'Ann Naylor Rifai/

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